

Docket 2024738-7030163001
CYM-032CON (11.015012)**REMARKS**

Upon the entering of this amendment, claims 16-26, 28-32, and 37-42 remain pending in the application. Claims 26, 28, 29, and 38-41 are currently amended, while claims 27 and 36 have been cancelled. Applicants have amended the claims for the sole purpose of clarifying their meaning. Applicants believe that the amendments do not change the scope of the claims, and thus do not necessitate a new search. Prior to the amendment, the term "die" was used in a confusing manner. As amended, the claims use the term "die" to refer to a tiny piece of semiconductor material capable of producing light (i.e., the light emitting portion of a conventional LED). Applicants note that the term "LED," as used in the claims, is intended to encompass conventional LEDs (i.e., a die surrounded by nonessential packaging material, such as plastic) as well as dies. Support for the claim amendments can be found in the original specification at page 16, lines 16-30, and in Figure 13. No new matter has been added.

Claim Rejections Under §103(a)

Claims 16, 22, 25, 26, 28, and 37-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wunderman et al., U.S. Patent 6,122,042, in view of Bennion, U.S. Patent 4,774,434. Applicants respectfully traverse this rejection.

Wunderman discloses an apparatus that is intended to be used to analyze and/or identify the properties of a material object using *reflected light*. The apparatus of Wunderman functions by shining light onto an object, allowing the light to be reflected off of the object, and then detecting and analyzing the light reflected from the object.

Bennion discloses a method of mounting LED-based light displays on clothing.

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In contrast to both Wunderman and Bennion, the present application, as claimed, presents a solution to the problem of finding alternative light sources for optical instruments such as microscopes. In view of the vast differences between the goals of Wunderman and Bennion, and the goals that led to the presently claimed invention, Applicants contend that Wunderman and Bennion are non-analogous art, and thus cannot be used as a proper basis for rejecting these claims.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). See also MPEP 2141.01(a).

Applicants submit with this response the declaration of David J. Zahniser, a named inventor on the present application, which states that he does not consider either the Wunderman or the Bennion reference to be in the same field of endeavor as the presently claimed invention, and furthermore, that neither reference would commend itself to his attention, since both references are concerned with problems completely unrelated to the problem of finding alternative light sources for optical instruments such as microscopes.

Applicants also dispute the combination of Wunderman and Bennion. To begin, there is no motivation to combine Wunderman and Bennion, since there has been no showing that the apparatus of Wunderman could be improved by the addition of one or more lenses. In addition, even if Wunderman could be improved by the addition of a lens, the combination of Wunderman

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and Bennion still fails to arrive at the present invention. As noted at page 2 of the Office Action dated August 29, 2005, "Wunderman is silent concerning a lens." The Office Action also notes, at pages 2-3, that Wunderman is silent concerning both a slide and Koehler illumination. The Office Action goes on to state that "official notice" is taken of the facts that "slides are well-known in the art as biological sample supports in microscopy" and that "Koehler illumination is well-known in the art for providing uniform illumination across a microscope slide." Wunderman's failure to mention so much that is well known in the world of microscopy is not a surprise since Wunderman is concerned with the use of reflected light to analyze the properties of an object. It is clear that Wunderman is not concerned with optical instruments such as microscopes, much less finding alternative sources of illumination for them. Bennion fails to compensate for the deficiencies of Wunderman as Bennion is completely silent about optical instruments.

Applicants submit with this response the declaration of David J. Zahniser. Dr. Zahniser's declaration states that he does not believe that the Wunderman and Bennion references could be combined to arrive at the presently claimed invention.

For at least the above reasons, Applicants respectfully request that this rejection be withdrawn.

Claims 17-21, 23, 24, 40, and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wunderman et al., U.S. Patent 6,122,042, in view of Bennion, U.S. Patent 4,774,434, and further in view of Ishihara et al., U.S. Patent 5,791,345. Applicants respectfully traverse this rejection.

Ishihara presents a solution to the problem of analyzing blood in a non-invasive manner. Given the differences between the problem confronted by Ishihara and the problem of finding

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alternative means of illumination for optical instruments such as a microscope, Applicants believe that Ishihara is non-analogous art that cannot be used as a proper basis for rejecting these claims.

In his declaration, Dr. Zahniser states that he does not consider the Ishihara reference to be in the same field of endeavor as the presently claimed invention, and furthermore, that the Ishihara reference would not commend itself to his attention, since it is concerned with a problem completely unrelated to the problem of finding alternative light sources for optical instruments such as microscopes.

Applicants further dispute the combination of Wunderman, Bennion, and Ishihara. Wunderman and Bennion have been discussed above. As for Ishihara, Applicants note that Ishihara teaches away from the use of microscopes. Ishihara is focused on *non-invasive* means of analyzing blood. To use a microscope to analyze blood, it would be necessary to first remove the blood from the patient. Such removal of the blood would be invasive, and therefore inconsistent with the objectives of Ishihara. Because Ishihara teaches away from the use of optical instruments such as microscopes, there is no motivation to combine the teachings of Ishihara with those of Wunderman and Bennion. In addition, even if there was motivation to combine Ishihara with Wunderman and Bennion, one could not arrive at the presently claimed invention. Ishihara does not disclose anything related to the problem of finding alternative light sources for optical instruments such as microscopes. Thus, Ishihara fails to compensate for the above-described deficiencies of Wunderman and Bennion.

In his declaration, Dr. Zahniser states that he does not believe that the Wunderman, Bennion, and Ishihara references could be combined to arrive at the presently claimed invention.

For the above reasons, Applicants respectfully request that this rejection be withdrawn.

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Claims 29-32, and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishihara et al., U.S. Patent 5,791,345, in view of Wunderman et al., U.S. Patent 6,122,042, and further in view of Bennion, U.S. Patent 4,774,434. Applicants respectfully traverse this rejection.

As discussed above, and as further supported by dr. Zahniser's declaration, Applicants believe that Ishihara, Wunderman, and Bennion are non-analogous art that cannot serve as a proper basis for the rejection of these claims. In addition, applicants believe that there is no motivation to combine the teachings of Ishihara, Wunderman, and Bennion, and that even if there was such motivation, the combination of Ishihara, Wunderman, and Bennion fails to arrive at the presently claimed invention.

For the above reasons, Applicants respectfully request that this rejection be withdrawn.

Conclusion

Applicant submits that a complete listing of all the claims have been provided with this response. In view of the above amendments to the claims and following remarks, all pending claims are now believed to be allowed over the cited reference, and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,
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Dated: _____

1/9/06

By: _____



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